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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/545,111 04/06/00 ANTONIOUS

A ADA-119

EXAMINER

021884 QM12/0828
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PASSANITI, S

ART UNIT

PAPER NUMBER

3711

DATE MAILED:

08/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Advisory Action

Application No.
09/545,111

Applicant(s)
ANTONIOUS

Examiner
SEBASTIANO PASSANITI

Art Unit
3711



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Aug 13, 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires THREE months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

4. ☒ Applicant's reply has overcome the following rejection(s) informality:
New claim 62 overcomes an objection in the manner in which old claim 61 was earlier presented.
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 1-41 and 52-61, as set forth in the final rejection, mailed 05/31/2001
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☒ Other: SEE ATTACHMENT TO ADVISORY ACTION

S. Passaniti
SEBASTIANO PASSANITI
PRIMARY EXAMINER
ART UNIT 3711

Art Unit: 3711

ATTACHMENT TO ADVISORY ACTION

The limitations omitted in the reissue are “unitary” , “at least at rigid as the tubular section” and “shorter than the tubular section” as they relate to the insert. This provides a broadening aspect to the reissue claims that was clearly argued in the original application to overcome the rejection based on the references of record. Thus, omission of “unitary” , “at least at rigid as the tubular section” and “shorter than the tubular section” is related to subject matter surrendered in the original application. By way of example, a narrowing limitation is also provided in reissue claim 52; i.e., a limitation that limits the tubular section to “a tubular section including a first end located at the butt end of the golf club shaft and a second end positioned slightly short of the distal end of the golf club shaft”. This narrowing limitation, however, is not at all related to the details of the insert and the manner in which these details defined over the prior art of record. Since the narrowing is not related to the prior art rejection and not related to the subject matter surrendered in the original application (omission of “unitary” , “at least at rigid as the tubular section” and “shorter than the tubular section”), recapture exists and claims 52, for example, is justly rejected under 35 U.S.C. §251. See *In re Clemont*, 131 F.3d 1464 USPQ2d 1161 (Fed. Cir. 1997).


Sebastiano Passaniti
Primary Examiner